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PATENT APPLICATION

ATTORNEY DOCKET NO. 10007750-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Carl S. Chow

Confirmation No.: 4263

Application No.: 09/905,579

Examiner: Robinson, Boyce Akiba K.

Filing Date: 12 JUL. 2001

Group Art Unit: 3628

Title: Literature Distribution Methods and Apparatus

Mail Stop Appeal Brief - Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Transmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on Sept. 6, 2007.

This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

No fee is required for filing of this Reply Brief.

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Respectfully submitted,

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By John S. Reid

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Date : 06 NOV. 2007

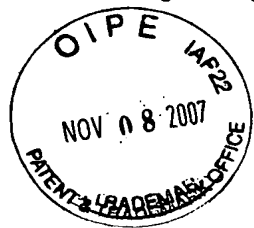
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PATENT APPLICATION
Docket No.: 10007750-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND
INTERFERENCES

In re application of:

Inventor(s):	Carl S. Chow
Serial No.:	09/905,579
Filed:	July 12, 2001
Title:	Literature Distribution Methods and Apparatus
Art Unit:	3628
Examiner:	Robinson, Boyce Akiba K.
Confirmation No.:	4263

Mail Stop APPEAL BRIEF – PATENTS
Commissioner for Patents
P.O. Box 1450
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REPLY BRIEF

SIR OR MADAM:

This communication is the Reply Brief in this application, and is in response to the Examiner's Answer mailed 08/13/2007. This Reply Brief is being filed under the provisions of 37 C.F.R. § 41.41(a)(1) and § 41.41(b).

(Continued on next page.)

Serial No. 09/905,579
Docket No. 10007750-1
Reply Brief

Status of the Claims:

The following list provides the status of all the claims in the application:

Claims 1-18: cancelled;

Claims 19-34: rejected – currently on appeal;

Grounds of Rejection to be Reviewed on Appeal:

A. Whether claims 19-34 fail to comply with the enablement requirement under 35 U.S.C. 112, first paragraph.

B. Whether claims 19-34 are unpatentable under 35 U.S.C. 103(a) as being obvious over US 6,134,568 to Tonkin in view of EP 0621563 A1 to Long.

Argument:

The Appellant has already made detailed arguments against the rejections of the claims in the Appeal Brief. Accordingly, the Appellant has responded herein only to specific arguments in the Examiner's Answer, as set forth in detail below.

1. Claim Rejections Under 35 U.S.C. 112 – The Examiner's Answer contains a detailed explanation of the rejection of claims 19-34 under 35 U.S.C. 112. Specifically, the Examiner's Answer, at pages 3 and 4, explains that independent claims 19 and 27 had been amended to contain the phrase, "wherein the client does not specify an arrangement of components to create the document," and that this phrase causes claims 19 and 27 to fail to comply with the enablement requirement.

As the Appellant has already explained in the Appeal Brief, claims 19 and 27 have been previously amended in a response to the final action. In that response to the final action, the Appellant deleted the phrase, "wherein the client does not specify an arrangement of components to create the document" and replaced it with the phrase, "assembling the selected data into a document, wherein the algorithm automatically specifies an arrangement of components to create the document."

The Appellant notes that the Examiner's Answer, at page 5, expressly argues that the cited prior art discloses "assembling the selected data into a document, wherein the algorithm automatically specifies an arrangement of components to create the document."

Moreover, the Appellant's Appeal Brief (at paragraph 4 "Status of Amendments") states the following:

Serial No. 09/905,579
Docket No. 10007750-1
Reply Brief

In the final action, all the claims were rejected under 35 U.S.C. 112, first paragraph, for failing to comply with the enablement requirement. These rejections were based on a phrase [wherein the client does not specify an arrangement of components to create the document] that had been added to claims 19 and 27 in a previous amendment. In a response to the final action, Appellant filed amendments to claims 19 and 27, wherein the phrase was substantially changed in order to overcome the rejections under 35 U.S.C. 112. In the advisory action, the Examiner indicated that the after final amendments would be entered for purposes of appeal. Also, the rejections under 35 U.S.C. 112 were not mentioned in the advisory action. The Appellant therefore assumes the rejections under 35 U.S.C. 112 have been overcome.

The Examiner's Answer indicates that the Appellant's statement of the status of amendments after final rejection, as contained in the Appeal Brief, is correct. Accordingly, because the Examiner has agreed with the Appellant's statement of the status of the amendments and has acknowledged that the phrase, which caused the 35 U.S.C. 112 rejections, has been deleted from the claims, and because arguments in the Examiner's Answer expressly rely on the new replacement phrase, the Appellant concludes that the after final amendments have, indeed, been entered. Therefore, because the claims no longer contain the phrase on which the Examiner based the rejections under 35 U.S.C. 112, the Appellant concludes that the Examiner has mistakenly upheld those rejections of the claims under 35 U.S.C. 112. That is, the Appellant concludes that the Examiner intended to withdraw the rejections of the claims under 35 U.S.C. 112 in view of the Appellant's after final amendments, but has not yet done so.

In the alternative, the Appellant argues that the claims fully comply with the enablement requirement of 35 U.S.C. 112, first paragraph, because the disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention.

2. **What Tonkin Discloses Compared with the Claims** – The Examiner cites lines 1-12 of the abstract of Tonkin at page 11 of the Examiner's Answer. The Examiner uses this cited passage of the abstract of Tonkin to argue that Tonkin discloses some of the limitations of the Appellant's claims.

5 However, the opposite is true. That is, the abstract of Tonkin actually teaches away from the Appellant's claimed invention. In the abstract, Tonkin discloses:

10 *"A system which enables a user to preview a document by providing a user interface and inputting, via the user interface, information specifying an arrangement of components to create the document...."* (Tonkin, lines 1-4 of the abstract.)

By contrast, the Appellant's claim 19 contains the following limitation:

15 *... in response to receiving the client selection, assembling the selected information into a document, wherein the algorithm automatically specifies an arrangement of components to create the document ...*

and, the Appellant's claim 27 contains the following limitation:

20 *... in response to receiving the client selection, assembling the selected data into a document, wherein the algorithm automatically specifies an arrangement of components to create the document ...*

25 That is, Tonkin expressly teaches that the user inputs information specifying the arrangement of the components to create the document, while the Appellant's claims require an algorithm that automatically specifies the arrangement of the components to create the document. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be led in a direction divergent from the path the applicant took. (*In re Gurley*, 27 F.3d at 551, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994).) In this instance a person of ordinary skill in the art, upon reading Tonkin, would be led to create means to enable the user to input information specifying the arrangement of components of a document. This is divergent from the path the Appellant took, which is to employ an algorithm to automatically specify the

arrangement of components of a document. Thus, not only does the cited prior art fail to disclose all the elements (e.g., the Appellant's algorithm), but also the cited prior art teaches away from the claimed invention.

3. **Application of KSR v. Teleflex** – The Examiner's Answer, at page 12, states, "[h]owever, KSR forecloses Appellant's argument that a specific teaching is required for a finding of obviousness."

While it is true that the Appellant contends that there is insufficient teaching, suggestion or motivation to combine the cited references, the Examiner has apparently misunderstood the Appellant's argument. That is, contrary to the Examiner's assertion, the Appellant has not argued that a specific teaching is required for a finding of obviousness. The Appellant contends that the Appellant's arguments in regard to lack of sufficient teaching, suggestion or motivation, as contained in the Appellant's Appeal Brief, are not inconsistent with the ruling in KSR.

Specifically, the decision in KSR only ruled against the application of the TSM test as a rigid, mandatory formula, and against the overemphasis on the importance of published articles and the explicit content of issued patents. (KSR v. Teleflex, 550 U.S. 15.) The Appellant's argument that the TSM standard has not been met, as set forth in the Appeal Brief, is not inconsistent with this ruling because the Appellant's argument does not depend on application of the TSM test as a rigid, mandatory formula, nor does the Appellant's argument depend upon and/or emphasize the importance of published articles and/or the explicit content of any issued patent.

4. **Regarding Impermissible Hindsight** – Beginning at page 12 of the Examiner's Answer, the Examiner attempts to rebut the Appellant's argument that impermissible hindsight reconstruction was used to reject the claims. In the Appellant's view, the Examiner has misunderstood the Appellant's argument. In the Appellant's argument, the Appellant is basically pointing out that the Examiner has used claim terminology taken directly from the Appellant's claims to explain why one of ordinary skill in the art would have been motivated to combine the reference teachings. The Appellant is arguing that the use of such language taken directly from the Appellant's claims is evidence of hindsight reconstruction because, in accordance with the proper standard, the TSM must not come from the Appellant's own application.

5. **Additional Arguments in Regard to What Long Discloses** – As the Examiner discusses at page 13 of the Examiner's Answer, Long teaches calculating postage for a plurality of documents after the documents have been produced and assembled. (Long, abstract.) Therefore, in accordance with the teachings of Long, the postage is necessarily affixed to the documents after the document images are printed. By contrast, the Appellant's claims specify printing the electronic image onto one or more sheets of print media, the electronic image comprising the document and a postage marking. That is, the Appellant's claims require the document and the postage marking to be printed as part of the same image. Thus, the teachings of Long are significantly divergent from the Appellant's claims.

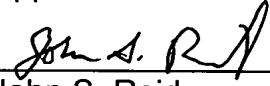
Summary

For at least the reasons stated herein above and in the Appellant's Appeal Brief, the Appellant asserts that none of claims 19-34 is obvious over the cited prior art. The Appellant respectfully requests that the Board overturn the final rejections of claims 19-34, and that those claims be allowed.

Dated this 6th day of November, 2007.

Respectfully submitted,
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Appellant

by



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